

REMARKS/ARGUMENTS

In view of the foregoing amendments and the following remarks, the applicants respectfully submit that the pending claims, are not anticipated under 35 U.S.C. § 102 and are not rendered obvious under 35 U.S.C. § 103. Accordingly, it is believed that this application is in condition for allowance. If, however, the Examiner believes that there are any unresolved issues, or believes that some or all of the claims are not in condition for allowance, the applicants respectfully request that the Examiner contact the undersigned to schedule a telephone Examiner Interview before any further actions on the merits.

The applicants will now address each of the issues raised in the outstanding Office Action.

Rejections under 35 U.S.C. § 102

Claims 7 and 15 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,804,659 ("the Graham patent"). The applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection in view of the following.

Before discussing at least some of the patentable features of the claimed invention, the Graham patent is introduced.

The Graham Patent

The Graham patent effectively considers a user's concepts of interest (e.g., from a user profile), advertisers' concepts and concepts of a currently viewed document to target advertising to the currently viewed document. (See, e.g., the Abstract.) More specifically, referring to Figures 1B, 4A and 4B, the Graham patent analyzes a document 100 with respect to user concepts 19 to generate a collection of concepts 20 relevant to the user. (See, e.g., element 102 of Figure 1B and steps 402 and 404 of Figure 4A.) Similarly, the Graham patent analyzes the document 100 with respect to concepts of ads 18 to generate a collection of concepts 22 relevant to ads. (See, e.g., element 104 of Figure 1B and steps 406 and 408 of Figure 4A.) The generated collection of concepts apparently includes a plurality of associated ads. (See, e.g., 22 of Figure 1B.) Finally, the concepts relevant to both the user and the currently viewed document are compared with concepts relevant to both advertisements and the currently viewed document to determine a "best" advertisement. (See, e.g., element 106 in Figure 1B, steps 410 and 412 of Figure 4A and Figure 4B.) Thus, as can be appreciated from the foregoing, advertisements can be retrieved "based upon a determined relevancy between the user's interests, ... the advertiser's concepts and the content of the current document being viewed." Column 5, lines 24-29.

Independent claims 7 and 15 are not anticipated by the Graham patent because the Graham patent does not teach using document information to determine additional content, using the additional content to determine further content, and combining at least portions of the document, the

determined additional content, and the determined further content for presentation to a user. Figure 7 of the present application illustrates an example of document information 710/752, additional content 720/754, and further content 740/756, all combined in document 750.

The Examiner contends that elements 1512 and 1514 of Figure 11A, and column 15, lines 13-19 of the Graham patent teach these features. However, the cited portions of the Graham patent merely show two ads 1512 and 1514 displayed in an ad space at the right margin of a browser screen 1503. Thus, the cited portions merely show using document content to determine additional content -- ads 1512 and 1514. They do not show using the additional content (e.g., ads 1512 and 1514) to determine further content, and combining at least portions of the document, the determined additional content (e.g., ads 1512 and 1514), and the determined further content for presentation to a user.

The Examiner seems to contend that a second ad 1514 is somehow determined using content of the first ad 1512. This is not true. The cited portion of the Graham patent states:

It is noteworthy that the advertisement displayed in area 1514 is directed to a broader aspect of the underlying concept of wearable computers than the advertisement displayed in area 1512.

Column 15, lines 13-17. However, this does not teach, nor does it imply, that the second ad 1514 is determined using content of the first ad 1512. Indeed, the Graham patent goes on to state that "These advertisements have been selected using the relevancy determining techniques

described herein." Column 15, lines 17-19. The determination techniques used by the Graham patent were introduced above. To reiterate, advertisements can be retrieved "based upon a determined relevancy between the user's interests, ... the advertiser's concepts and the content of the current document being viewed." Column 5, lines 24-29. This in no way teaches that further content (e.g., a second ad) is determined using content of additional content determined from document information (e.g., a first ad determined from a document).

Thus, independent claims 7 and 15 are not anticipated by the Graham patent for at least the foregoing reason.

Rejections under 35 U.S.C. § 103

Claims 1 and 9 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the Graham patent. The applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection in view of the following.

Independent claims 1 and 9, as amended, are not rendered obvious by the Graham patent because the Graham patent neither teaches, nor suggests, using information of at least one ad to determine information in addition to the at least one ad, and combining at least a portion of the at least one ad and the additional information for presentation to a user together with page content, wherein the page content is not directly used to determine the determined content. Figure 5 of the present application illustrates an example of ad information 510, additional content 520, and the ad content 556 and the additional content 554 combined in document 550 along with Web page

515 content 552. Notice that the additional content 554 is determined from the ad content 510/556, but not directly from the Web page content 515/552.

As discussed above, the Graham patent teaches using user concepts, document concepts, and ad concepts to determine ads to be shown, to the user, with the document. The determined ads are not used to determine information in addition to the ads.

The Examiner argues that column 4, lines 51-54 of the Graham patent teaches that advertisements are Web page content. However, the cited portion of the Graham patent merely notes that ads can be displayed in a user's browser. As shown in Figure 11A, the ads 1512 and 1514 are provided in a portion of the browser screen 1503 separate from the document. This might be to avoid "reformatting the web page". (See, e.g., column 1, lines 42-45.) Even if the Web page included embedded advertisements, claims 1 and 9, as amended, recite combining at least a portion of the at least one ad and the additional information for presentation to a user *together with page content, wherein the page content is not directly used to determine the determined content.* Thus, even assuming that the Graham patent can use a Web page with embedded advertisements to determine further advertisements, the portions of the Webpage not embedded with advertisements are directly used to determine the additional advertisements. This is unlike the case where the page content is not directly used to determine advertisements as claimed, an example of which is illustrated in Figure 5 of the present application. Thus, claims 1 and 9, as amended, are not rendered obvious by the Graham patent for at least this reason.

Claims 2 and 10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the Graham patent in further view of U.S. Patent No. 6,505,169 ("the Bhagavath patent") and Edmunds.com, page 1, January 22, 2001 ("the Edmunds page"). The applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection in view of the following.

The Bhagavath patent is cited as teaching ad meta data including display constraints. The cited portion of the Bhagavath patent concerns using audience demographics, time and date to constrain the serving of ads inserted into streaming media. (See, page 6, lines 24-35.) Even assuming, arguendo, that one skilled in the art would have been motivated to modify the system discussed in the Graham patent to consider such ad meta data to constrain the display of ads, this combination does not compensate for the deficiencies, discussed above, of the Graham patent with respect to claims 1 and 9, as amended.

The Edmunds page is cited as showing a product review in a right hand side of the page. However, this product review is apparently just a portion of an authored article. That is, based merely on the page printout, the applicants believe that the photo caption is not **determined using ad information**, but is simply part of an authored article. Thus, claims 2 and 10 are not rendered obvious by the Graham and Bhagavath patents and the Edmunds page for at least this reason.

Further, even assuming, arguendo, that the Edmunds page includes the purported teaching, and further assuming, arguendo, that one skilled in the art would have been motivated to make the combination proposed by the Examiner, the proposed combination would still not compensate for the

deficiencies, discussed above, of the Graham patent with respect to claims 1 and 9, as amended. Thus, claims 2 and 10 are not rendered obvious for at least this additional reason.

Finally, since the cited art does not suggest the combination proposed by the Examiner, the proposed combination is apparently the product of impermissible hindsight. Consequently, these claims are not rendered obvious for at least this additional reason.

Claims 3, 8, 11 and 16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the Graham patent in further view of the Bhagavath patent and CNET.com, page 1, December 7, 2001 ("the CNET page"). The applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection in view of the following.

As discussed above, the Bhagavath patent is cited as teaching ad meta data including display constraints (e.g., audience demographics, time and date) to constrain the serving of ads inserted into streaming media. Even assuming, arguendo, that one skilled in the art would have been motivated to modify the system discussed in the Graham patent to consider such ad meta data to constrain the display of ads, this combination does not compensate for the deficiencies, discussed above, of the Graham patent with respect to claims 1 and 9, as amended. Further, this combination does not compensate for the deficiencies, discussed above, of the Graham patent with respect to claims 7 and 15.

The CNET page is cited as showing a service review. However, based merely on the page printout, the applicants believe that the service review is not determined using ad

information. Thus, claims 3 and 11 are not rendered obvious by the Graham and Bhagavath patents and the CNET page for at least this reason. Further, the applicants believe that the service review is not *further information determined from additional content which was determined from document content*. Thus, claims 8 and 16 are not rendered obvious by the Graham and Bhagavath patents and the CNET page for at least this reason.

Further, even assuming, arguendo, that the CNET page includes the purported teaching, and further assuming, arguendo, that one skilled in the art would have been motivated to make the combination proposed by the Examiner, the proposed combination would still not compensate for the deficiencies, discussed above, of the Graham patent with respect to claims 1 and 9, as amended. Thus, claims 2 and 11 are not rendered obvious for at least this additional reason.

Furthermore, even assuming, arguendo, that the CNET page includes the purported teaching, and further assuming, arguendo, that one skilled in the art would have been motivated to make the combination proposed by the Examiner, the proposed combination would still not compensate for the deficiencies, discussed above, of the Graham patent with respect to claims 7 and 15. Thus, claims 8 and 16 are not rendered obvious for at least this additional reason.

Finally, since the cited art does not suggest the combination proposed by the Examiner, the proposed combination is apparently the product of impermissible hindsight. Consequently, these claims are not rendered obvious for at least this additional reason.

Claims 4 and 12 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the Graham patent and the Bhagavath patent in further view of MSN.com, page 1, December 7, 2002 ("the MSN page"). The applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection in view of the following.

As already discussed above, the Bhagavath patent is cited as teaching ad meta data including display constraints (e.g., audience demographics, time and date) to constrain the serving of ads inserted into streaming media. Even assuming, arguendo, that one skilled in the art would have been motivated to modify the system discussed in the Graham patent to consider such ad meta data to constrain the display of ads, this combination does not compensate for the deficiencies, discussed above, of the Graham patent with respect to claims 1 and 9, as amended.

The Examiner contends that the MSN page teaches an ad for a service (MSN messenger) and news about the service. However, the news is apparently just a portion of an authored document. That is, based merely on the page printout, the applicants believe that the news about MSN messenger was not *determined using ad information*, but is simply part of an authored article. Thus, claims 4 and 12 are not rendered obvious by the Graham and Bhagavath patents and the MSN page for at least this reason.

Further, even assuming, arguendo, that the MSN page includes the purported teaching, and further assuming, arguendo that one skilled in the art would have been motivated to make the combination proposed by the Examiner, the proposed combination would still not compensate for the deficiencies, discussed above, of the Graham patent with respect to claims 1 and 9, as amended. Thus, claims 4 and

12 are not rendered obvious for at least this additional reason.

Finally, since the cited art does not suggest the combination proposed by the Examiner, the proposed combination is apparently the product of impermissible hindsight. Consequently, these claims are not rendered obvious for at least this additional reason.

Claims 5 and 13 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the Graham patent in further in view of U.S. patent No. 6,006,225 ("the Bowman patent"). The applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection in view of the following.

The Examiner cites the Bowman patent as teaching a search query related to a document as being "determined content". First, in the Bowman patent, related terms are suggested to allow a user to refine a search. The related terms are generated using query term correlation data, which may be generated and stored in an off-line process which processes a query log file. (See, e.g., the Abstract.) Thus, the search query information is not *generated from ad document information* as claimed. Consequently, claims 5 and 13 are not rendered obvious by the Graham and Bowman patents for at least this reason.

Second, even assuming, arguendo, that the Bowman patent includes the purported teachings, and further assuming, arguendo, that one skilled in the art would have been motivated to combine the Graham and Bowman patents as proposed by the Examiner, the combination does not compensate for the deficiencies of the Graham patent, discussed above, with respect to claims 1 and 9 as amended.

Finally, since the cited art does not, suggest the combination proposed by the Examiner, the proposed combination is apparently the product of impermissible hindsight. Consequently, these claims are not rendered obvious for at least this additional reason.

Claims 6 and 14 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the Graham patent in further view of U.S. Patent Application Publication No. US2004/0093558A1 ("the Weaver publication"). The applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection in view of the following.

The Examiner cites the Weaver publication as teaching a message database that stores messages from a user group. The Weaver publication concerns copying messages from a first forum to a new forum. (See, e.g., the Abstract.) The message is not generated from ad document information as claimed. Consequently, claims 6 and 14 are not rendered obvious by the Graham patent and Weaver publication for at least this reason.

Second, even assuming, arguendo, that the Weaver publication included the purported teachings, and further assuming, arguendo, that one skilled in the art would have been motivated to combine the Graham patent and the Weaver publication as proposed by the Examiner, the combination does not compensate for the deficiencies of the Graham patent, discussed above, with respect to claims 1 and 9 as amended.

Finally, since the cited art does not suggest the combination proposed by the Examiner, the proposed combination is apparently the product of impermissible

hindsight. Consequently, these claims are not rendered obvious for at least this additional reason.

New claims

New claims 17-20 depend from claims 2, 3, 4 and 7, respectively, and further recite that certain acts are preformed automatically by a machine executing machine-executable instructions. These claims are supported, for example, page 18, line 12 through page 19, line 19. These claims further distinguish the claimed invention over pages with different types of content manually authored.

Conclusion

In view of the foregoing amendments and remarks, the applicants respectfully submit that the pending claims are in condition for allowance. Accordingly, the applicants request that the Examiner pass this application to issue.

Respectfully submitted,

August 19, 2006


John C. Pokotylo, Attorney
Reg. No. 36,242
Customer No. 26479
(732) 542-9070

STRAUB & POKOTYLO
620 Tinton Avenue
Bldg. B, 2nd Floor
Tinton Falls, NJ 07724-3260

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this paper (and any accompanying paper(s)) is being facsimile transmitted to the United States Patent Office on the date shown below.

John C. Pokotylo

Type or print name of person signing certification

John C. Pokotylo
Signature

August 19, 2006

Date